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10/668,244	09/24/2003	Shinji Yamadaji	04329.3146	2060
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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER BENGZON, GREG C	
			ART UNIT	PAPER NUMBER
			2144	
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			06/15/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/668,244

Applicant(s)

YAMADAJI, SHINJI

Examiner

Greg Bengzon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 09/24/2003, 05/27/2005
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This application has been examined. Claims 1-12 are pending.

Priority

This application claims benefits of priority from Foreign Application 2002-315912 (JAPAN) filed October 30, 2002.

The effective date of the claims described in this application is October 30, 2002.

Information Disclosure Statement

The information disclosure statements (IDS) submitted on 09/24/2003, 05/27/2005 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement are being considered by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5,6,11,12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. The term "*predict content of the instruction*" is used by the claim to mean "*present search results*", while the accepted meaning is "anticipate the result". The term is indefinite because the specification does not clearly redefine the term.

For purposes of this examination, the limitation regarding '*predicting content*' is interpreted according to the Applicant Specifications as described in Page 19 Lines 5-15. Accordingly '*predicting content*' is equivalent to searching a program information database and presenting search results to the user.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 7-10 rejected under 35 U.S.C. 102(e) as being anticipated by Shimamura (US Publication 2001/0003827).

Shimamura disclosed (re. Claim 1,7) a control apparatus which controls first and second electronic devices, comprising: means for assigning first and second electronic mail addresses to the first and second electronic devices, (Shimamura-Paragraph 20, Paragraph 104) respectively; a receiving unit which receives an electronic mail via a network, (Shimamura-Paragraph 20, Paragraph 30) the electronic mail including one of the first and second electronic mail addresses as a destination address; (Shimamura-Paragraph 91) means for selecting one of the first and second electronic devices in accordance with the destination address (Shimamura-Paragraph 93) of the received electronic mail; and means for controlling an operation of the selected electronic device based on an instruction described in the received electronic mail. (Shimamura-

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Paragraph 20)

Claim 7 is rejected on the same basis as Claim 1.

Shimamura disclosed (re. Claim 2,8) a storage unit which stores access control information indicating a relationship between an electronic mail address of each user who gains access to the control apparatus and an electronic device that is controllable by the user; (Shimamura-Paragraph 20, '*authorization to execute the command*') and means for performing an access control process which allows the electronic device selected in accordance with the destination address to be controlled or inhibits the electronic device from being controlled, based on a sender address (Shimamura-Paragraph 13, '*certifies each email by the email address*') and the destination address of the received electronic mail and the access control information.

Shimamura disclosed (re. Claim 3,9) wherein the controlling means includes: means for generating a command, which is interpreted by the selected electronic device, based on the instruction described in the received electronic mail; (Shimamura-Figure 3, '*command analyzer*') and means for sending the command to the selected electronic device.

Shimamura disclosed (re. Claim 4,10) wherein the controlling means includes: means for analyzing a message composed in the received electronic mail to extract a keyword, which is available as the instruction, from the message; (Shimamura-Figure 3, '*command analyzer*') means for generating a command, which is interpreted by the selected electronic device, based on the extracted keyword; and means for sending the command to the selected electronic device. (Shimamura-Paragraph 91, '*enable the printer to interpret the command*')

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5,6,11, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimamura (US Publication 20010003827) in view of Hirata (US 6374406) further in view of Kunii (US Patent 7095402).

Shimamura disclosed (re. Claim 5) and the controlling means includes: means for analyzing a message composed in the received electronic mail (Shimamura-Figure 3, '*command analyzer*') including the first electronic mail address as a destination address to extract a keyword from the message;

While Shimamura substantially disclosed the invention, Shimamura did not disclose (re. Claim 5) wherein the first electronic device is configured to record a broadcast program. Shimamura did not disclose (re. Claim 5) means for predicting contents of the instruction based on both the extracted keyword and a database indicating broadcast date and time, a channel number and an attribute of each broadcast program; and means for controlling a recording operation of the first electronic device based on prediction results.

Hirata disclosed (re. Claim 5) wherein the first electronic device is configured to record a broadcast program. (Hirata-Column 5 Lines 40-50)

Shimamura and Hirata are analogous art because they present concepts and practices regarding delivery of remote control commands to a device via email. At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine Hirata into Shimamura. The motivation for said combination would have been to eliminate the requirement for telephone lines for controlling an electric appliance from outside the house.(Hirata-Column 1 Lines 35-45)

For purposes of this examination, the limitation regarding '*predicting content*' is interpreted according to the Applicant Specifications as described in Page 19 Lines 5-15. Accordingly '*predicting content*' is equivalent to searching a program information database and presenting search results to the user.

Kunii disclosed (re. Claim 5) means for predicting contents of the instruction based on both the extracted keyword (Kunii-Column 25 Lines 20-30) and a database indicating broadcast date and time, a channel number and an attribute of each broadcast program; and means for controlling a recording operation of the first electronic device based on prediction results.

Shimamura, Hirata, and Kunii are analogous art because they present concepts and practices regarding delivery of remote control commands to a device via email. At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine Kunii into Shimamura-Hirata. The motivation for said combination would have been to allow for users to select desired programs without having to browse through the program listing. (Kunii-Column 1 Lines 55-65)

Claim 11 is rejected on the same basis as Claim 5.

Shimamura-Hirata-Kunii disclosed (re. Claim 6, 12) wherein the controlling means includes: means for analyzing a message composed in the received electronic mail (Shimamura-Figure 3, '*command analyzer*') to predict contents of the instruction (Kunii-Column 25 Lines 20-30) described in the received electronic mail; means for

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composing a message indicating the predicted contents of the instruction; (Kunii-Column 25 Lines 20-30) and means for returning an electronic mail (Shimamura-Paragraph 97) including the composed message to a sender of the received electronic mail.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please refer to the enclosed PTO-892 form.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Bengzon whose telephone number is (571) 272-3944. The examiner can normally be reached on Mon. thru Fri. 8 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on (571)272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

gcb



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